

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of Davis et al

Art Unit 3625

Confirmation No. 5321

Application No.: 09/502,542

Filed: February 10, 2000

For: METHOD AND SYSTEM FOR
FACILITATING ON-LINE SHOPPING

VIA ELECTRONIC FILING

Examiner: M. Fadok

Date: September 11, 2006

REPLY BRIEF

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Sir:

This Reply Brief responds to the Examiner's Answer mailed July 11, 2006.

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I. Claim 1 (§ 102: Swartz)

Claim 1 concerns compiling a list of retail items of interest in a bricks and mortar store (through sensing of barcodes or the like), *and later use of that list to present to a consumer a customized selection of items in an on-line shopping environment.*

The *Examiner's Answer* contends this is taught by Swartz's Figs. 3 and 4.¹

Not so. The Examiner treats the claim term "*on-line shopping environment*" like the proverbial "nose of wax" that can be twisted and turned in any direction.

In particular, the Examiner contends that Swartz's patented self-checkout system comprises an "on-line shopping environment" because it accesses a store computer through a network access point (Figs. 3 and 4).

However, Swartz's specification makes clear that his system (including the store computer, etc.) is implemented in a *bricks and mortar* store. For example, his store has "shelves"² and includes several "checkout registers."³ While shopping, a consumer uses Swartz's hardware to scan bar codes from each product he wants to purchase⁴ when he takes products from the shelves – saving the cashier at the checkout register the trouble of scanning the items.⁵

In contrast, Appellants' specification makes clear an on-line shopping environment means something *different* than a bricks and mortar shopping environment.

A bricks and mortar store is described in Appellants' specification as including shelves,⁶ aisles,⁷ etc. (like Swartz's store). Appellants' specification gives "a supermarket" as an example of a bricks and mortar environment.⁸

On the other hand, Appellants describe an on-line shopping environment as a "virtual"⁹ one in which a consumer interacts with a computer to select products for purchase through use of

¹ *Examiner's Answer*, page 10, lines 2-5.

² Swartz, col. 4, line 23.

³ Swartz, col. 7, line 33.

⁴ Swartz, col. 3, lines 43-45.

⁵ Swartz, col. 3, lines 55-58.

⁶ See, e.g., Specification, page 3, line 29.

⁷ See, e.g., Specification, page 3, line 11.

⁸ See, e.g., Specification, page 2, lines 20-21; page 6, line 25.

⁹ See, e.g., Specification, page 1, line 10; page 3, line 15; page 7, lines 10-11; page 8, line 19.

a computer user interface.¹⁰ Items are presented through textual or graphical representations,¹¹ rather in physical form. Moreover, Appellants' specification describes an on-line shopping environment as sometimes giving the consumer the option of selecting between home delivery or in-store pickup for the purchased items¹² – indicating that the consumer “shopping” activity takes place remotely from any store inventory of physical items.

Swartz's arrangement does not have these hallmarks. Swartz's consumer deals with physical products, stocked on shelves. He doesn't act in a virtual environment. The consumer doesn't select products based on textual or graphical product representations through a computer user interface. The shopping activity does not take place remotely from the product inventory. Swartz does not teach an “on-line shopping environment,” as that claim term is properly construed.

Accessing a store computer through a network access point does not make an on-line shopping environment. Indeed, Appellants' specification shows such elements in their illustrated *bricks and mortar* supermarket (“retail store”): *see, e.g.*, store computer system 14 in Appellants' Fig. 1, which is accessed over a wireless link by portable device 10 in Fig. 3.

The construction urged by the Examiner would have the anomalous result that Swartz's store is simultaneously both a “bricks and mortar” store, and an “on-line shopping environment.” Such a construction is untenable. It does not give effect to the claim language and specification, which expressly draws a distinction between these two terms. The interplay between the two differently-termed environments is a theme that is emphasized repeatedly throughout Appellants' specification, *e.g.*:

*In accordance with one embodiment of the present invention, the initial user-interface hurdle to a satisfying shopping experience is overcome by permitting the user to compile a favorites list through shopping in one or more **bricks-and-mortar stores**.... When the user shops **on-line**, a personalized shopping environment is presented, featuring the items **previously purchased in the bricks and mortar store(s)**.¹³*

and

¹⁰ *See, e.g.*, Specification, page 1, lines 10-25; page 4, lines 20-21; page 5, lines 5-6, 21; page 6, lines 22-23.

¹¹ *Ibid.*

¹² *See, e.g.*, Specification, page 5, lines 6-8.

¹³ *See, e.g.*, Specification, page 1, lines 24-30.

When the shopper thereafter shops on-line at a participating vendor through the on-line storefront computer 22, a list detailing all goods previously-purchased at the bricks and mortar store(s) is retrieved from storage 15 and presented to the user, permitting the on-line shopping experience to be enhanced, as detailed below.¹⁴

Giving both terms the same meaning robs the terms of their distinctive meanings. Such distortion of claim terms is error.

Swartz does not teach the method of claim 1; the rejection must be reversed.

II. Claim 20 (§ 102: Swartz)

The rejection of independent claim 20 similarly fails.

As noted above, Swartz does not teach use of data collected about products of interest during a shopper's visit to a bricks and mortar store, in a later on-line shopping session with that shopper.

The Examiner's construction draws no distinction between the former "visit" and the "later ... session." Nor does the Examiner's construction acknowledge the difference between a "bricks and mortar store" and "on-line shopping." Blurring these different terms, to give them homogenized meanings, is error.

III. Claims 21 and 25 (§ 102: Swartz)

The *Response to Arguments* offered in the *Examiner's Answer* does not address the methods of claims 21 and 25 (dependent from claims 20 and 1, respectively), which claims were argued separately in the *Appeal Brief*.

IV. Claim 22 (§ 102: Swartz)

Claim 22 (dependent from claim 20) concerns collection of data through activation of a "shelf-based sensor associated with a product of interest."

¹⁴ See, e.g., Specification, page 3, lines 1-4.

The *Examiner's Answer* contends this limitation is met by Swartz's barcode reader.¹⁵

Not so. Swartz's barcode reader is a portable terminal carried by the shopper.¹⁶ It is not "shelf-based."

In contrast, the corresponding disclosure of Appellants' specification details an arrangement in which the consumer does not carry a reader device, but rather carries a passive barcode-encoded card.¹⁷ The consumer presents this card to a shelf-mounted reader associated with an item of interest, causing the associated system to log that consumer's interest in that item.¹⁸

Again, Swartz does not teach that for which it has been cited.

V. **Claim 7 (§ 102: Swartz)**

Claim 7 is somewhat the mirror image of claim 20, e.g., involving database-logging of a shopper's habits or preferences in an on-line shopping environment, and using the database information in connection with bricks and mortar shopping by the user.

This arrangement was not addressed in the *Response to Arguments* included with the *Examiner's Answer*. Again, only by gross distortion of the claim terms can any mapping to Swartz be achieved. Again, Swartz does not anticipate.

VI. **Claim 3 (§ 103: Swartz + Osagawara)**

Again, this independent claim was not addressed in the *Response to Arguments* included with the *Examiner's Answer*.

Again, there is no rebuttal of Appellants' earlier showing that:

- Swartz does not involve the required "on-line shopping session" (instead, his invention is described in the context of a bricks and mortar store);

¹⁵ *Examiner's Answer*, page 10, lines 12-13.

¹⁶ *See, e.g.*, Swartz col. 7, lines 41-42.

¹⁷ Specification, page 3, lines 27-29.

¹⁸ *Ibid.*

- Osagawara does not involve the required “on-line shopping session” (instead, his invention is also described in the context of a bricks and mortar store); and
- The Final Rejection impermissibly used Appellants’ claim as a guide in modifying and combining the references.

The Office’s *prima facie* burden has not been met.

VII. Claims 5, 6, 13 and 14 (§ 103: Swartz + Osagawara)

The Final Rejection did not address the limitations introduced by these dependent claims, as Appellants pointed out in their *Appeal Brief*. Yet the *Examiner’s Answer* did not attempt to cure such highlighted deficiencies.

Nor has any attempt been made to rationalize an artisan’s necessary motivation to modify art to yield such arrangements.

Again, *prima facie* obviousness has not been established.

VIII. Claims 26+27 (§ 103: Swartz + Official Notice + *St Regis Paper v. Bemis Co*)

Again, the *Appeal Brief* pointed out the factual and legal problems with the rejections of these dependent claims (*e.g.*, the claims do not involve duplicating elements in a system, and obviousness must always be determined on a case-by-case basis – not by a *per se* rule derived from a 7th Circuit decision).

Again, the *Examiner’s Answer* did not attempt to redress these deficiencies.

Again, *prima facie* obviousness has not been established.

IX. Claims 9 and 15-19 (§ 103: Kenney + Swartz)

The *Examiner’s Answer* did not further address any of these claims, nor attempt to redress the shortcomings noted in the *Appeal Brief*.

X. Conclusion

Swartz anticipates none of the claims. Nor has the Office met the *prima facie* burden required in connection with the rejections under § 103. The rejections should be reversed, and the case passed to issuance.

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CUSTOMER NUMBER 23735

Phone: 503-469-4800

FAX 503-469-4777

Respectfully submitted,

DIGIMARC CORPORATION

By 

William X. Conwell
Registration No. 31,943